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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,959	04/12/2004	Bernhard Geuppert	861840-999025	2358
51442	7590	08/17/2007		
JONES DAY 222 East 41st Street New York, NY 10017-6702			EXAMINER KIM, PAUL D	
			ART UNIT 3729	PAPER NUMBER
			MAIL DATE 08/17/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/821,959

Applicant(s)

GEUPPERT ET AL.

Examiner

Paul D. Kim

Art Unit

3729

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 9-16, 20, 23 and 26-39 is/are pending in the application.
- 4a) Of the above claim(s) 27, 31 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 9-16, 20, 23, 26, 28-30, 32-36, 38 and 39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is a response to the amendment filed on 6/1/2007.

#### ***Election/Restrictions***

1. Newly submitted claims 27, 31 and 37 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The limitations as recited in claims 27, 31 and 37 appear to belong to the non-elected Species F, which is at least two substrates are mounted on the mounting frame.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, the claims 27, 31 and 37 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

#### ***Claim Objections***

2. Claims 27, 31 and 37 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. There is no process of mounting another substrate on the mounting frame in claims 9 and 23.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 9-15, 20, 23, 28, 29, 34-36, 38 and 39 are rejected under 35

U.S.C. 102(e) as being anticipated by Oshino (EP 1338911 A2).

Oshino teaches a process of making an optical component comprising steps of: mounting a substrate (20) on a mounting frame (25) as shown in Fig. 2(a); measuring a shape of the optical surface of the substrate; and processing the optical surface as disclose in col. 15, the paragraph [0055], wherein the substrate is mounted on the mounting frame during the measuring and the processing the optical surface (see also paragraph [0032] to paragraph [0039] and paragraph [00472] to paragraph [0055]). Oshino also shows the optical system as shown in Fig. 1 (also see paragraph [0032] to [0034], as per claims 20 and 23).

As per claim 10 the substrate is permanently mounted on the mounting frame during the measuring and the processing the optical surface.

As per claims 11, 23 and 35 the mounting frame comprises three contact portions (22) or plural attachment members disposed at distances from each other as shown in Fig. 2(a) for providing a mounting contact.

As per claim 12 the mounting frame is mounted to at least one adjacent mounting frame (40) as shown in Fig. 5.

As per claim 13 Oshino also teaches that the error (equivalent with a difference) is removed while the substrate is mounted on the frame (see paragraph [0048]).

As per claim 14 the measuring of the shape of the substrate is performed while the substrate is disposed in an orientation with respect to a direction of gravity (such as downward), which is substantially the same as the predetermined orientation as shown in Fig. 2(b).

As per claim 15 the process of the optical surface is performed by polishing.

As per claims 26, 30 and 35 the mounting frame is configured to support the substrate.

As per claims 28, 32 and 38 the mounting frame is a ring shaped member as shown in Fig. 2(a).

As per claims 29, 33 and 39 the mounting frame comprises a continuous member to provide supporting the substrate at multiple locations as shown in Fig. 2(a).

5. Claims 9, 10, 13 -11 are rejected under 35 U.S.C. 102(b) as being anticipated by Le Saux et al. (US PAT. 5,581,347).

Le Saux et al. teach a process of making an optical component comprising steps of: mounting lens on a mounting apparatus as shown in step 50; measuring a shape of the optical surface of the substrate as shown in steps 53-56; and processing the optical surface as disclose as shown in step 57 as shown in Fig. 6, wherein the lens are mounted on the mounting apparatus during the measuring and the processing the optical surface (see also col. 8, line 55 to col. 14, lines 26). Le Saux et al. also show the optical system as shown in Figs. 3-5 (as per claims 20 and 23).

As per claim 10 the substrate is permanently mounted on the mounting frame during the measuring and the processing the optical surface.

As per claim 13 the processing process is performed based on the measurement.

***Claim Rejections - 35 USC § 103***

6. Claims 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over either Oshino or Le Saux et al. and in view of Malyak et al. (US PAT. 6,515,750).

Either Oshino or Le Saux et al. teaches all of the limitations, but fail to disclose how the measuring process is preformed. Malyak et al. teach an interferometric system for an optical component in order to allow measuring semi-transparent optical objects (see also col. 6, lines 36-41). Therefore, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify a process of measuring the surface of the optical component of either Oshino or Le Saux et al. by

using an interferometric system as taught by Malyak et al. in order to allow measuring semi-transparent optical objects.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 9-16, 20, 23 and 26-39 have been considered but are moot in view of the new ground(s) of rejection.

8. Applicant's arguments filed 6/1/2007 have been fully considered but they are not persuasive. Applicant argues that the mounting frame of Oshino is different for different measuring and processing tasks as recited in the claimed invention. Examiner traverses the argument. The mounting frame of the claimed invention is for mounting the substrate to assemble the optical component. The mounting frame of Oshino is for holding or mounting the optical component as shown in Fig. 2 (a) and (b). Therefore, the mounting frame of Oshino is satisfied and taught the mounting frame of the claimed invention. In addition, as indicated by applicant, the mirror (or substrate) can be hold by a different holding frame while the measuring or polishing process is performing. The mounting frame of Oshino can be the anchoring members with the different holding frame for the measuring or polishing process. Again, the mounting frame of the claimed invention is only for mounting the substrate to assemble the optical component. Also, applicant argues that the processing process of Le Saux et al. does not teach the processing process as recited in the claimed invention. Examiner also traverses the argument. There is no such recitation in the claimed invention what the processing process does. According to the recitation in claim 9, the optical surface of the substrate

is processed. There is no such recitation what kind of processing is performed. The processing process of Le Saux et al. teaches that the possessing of measuring is performed by computer means. Therefore, the processing process of Le Saux et al. is satisfied and taught the process of processing the optical surface of the substrate of the claimed invention.

### ***Conclusion***

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul D. Kim whose telephone number is 571-272-4565.

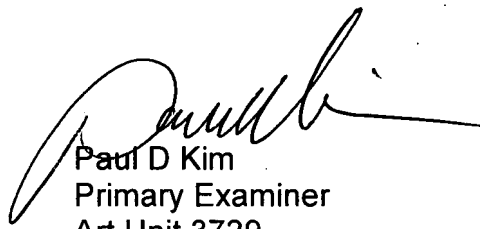


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The examiner can normally be reached on Monday-Thursday between 6:00 AM to 2:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Paul D Kim  
Primary Examiner  
Art Unit 3729